

## REMARKS/ARGUMENT

### ***Regarding the Claim Rejections under 35 U.S.C. 103***

Applicant acknowledges the quotation of the appropriate paragraphs of 35 U.S.C. 103 that forms the basis for the rejections under this section made in the office action.

Claims 1-12, 18 and 26 and 32-38 have been rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Publication 2002/37364 (Nagura) In combination with U.S. Patent 4,808,496 (Hope). Applicant respectfully disagrees with this obviousness rejection in light of the amendments to the claims and arguments above supporting the aqueous processability of the original claim.

Further, The Examiner has indicated that as best understood the cited combination would be an obvious combination to yield Applicant's claimed invention. Applicant in claim 1 has claimed a coating layer covering substantially all of said exterior surface area of the particle in the original submission of claim 1, and the amended submission. It was noted to the Examiner, the art cited on the previous office action, lacked this stated element from the original claims and amended claims. The Examiner now responds with the citation of Hope, stating that Hope coats the entire surface of the particle, so it would be an obvious combination with Nagura.

The cited references appear to have been found after a thorough search of the prior art for the individual features of Applicants' invention noted as lacking in the citations of the art of the previous office action.

Such a rejection based on using applicant's claimed invention as a teaching guide as the Court of Appeals for the Federal Circuit noted in Connell et al. v. Sears, Roebuck & Co. (CA FC, 1983), 20 USPQ 193 at 199, is not proper:

"The opinion says obviousness is established when 'features that distinguish' the invention from the closest reference 'are disclosed in analogous structures in which the features perform the identical function'. It is not 'features' but the subject matter as a whole which must be considered, 35 U.S.C. 103. That features, even distinguishing features, are 'disclosed in the prior art' is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made."

Further, the coating of Hope is Hygroscopic and cannot be processed into an electrode in a water or aqueous solvent because the lithium salt or other inorganic salts communicating with the surface in to yield the stated requirement of ionic conductivity, will dissolve in water. (See Hope Column 2, 10-16; column 4 lines 8-13). It lacks the element of applicant's device of a substantially all of said exterior surface area, with the coating layer comprised of substantially hydrophobic coating material, allowing for processing using aqueous solutions.

Similarly, as noted above, Figure 1 in Nagura, clearly teaches that the active material layer particles are not coated by a layer of a polymer coating, but rather contain gaps where the particles are not coated. These gaps result from the manner of the coating of the particles as discussed in Nagura. Further, there is no disclosure or teaching in Nagura of eliminating the gaps between different coating elements in Nagura because the purpose of Nagura is to restrict the dimensional change of the formed electrode and not to create a hydrophobic protective layer on each particle to allow formation of the electrode using aqueous solutions.

"Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

The prior art of Nagura fails to teach or suggest covering the entire particle with hydrophobic material. The art of Hope, actually teaches inclusion of lithium salt in communication with the exterior polymer surface rendering the Hope surface hygroscopic. There is no incentive to take the hygroscopic surface of Hope and combine it with the spaced surface of Nagura to yield a hydrophobic surface covering the entire exterior of each particle since the Hope material is hygroscopic and employing the surface of Hope on Nagura still yields a hygroscopic coating incapable of processing with water. Neither does Nagura teach or suggest such a combination since the gaps of Nagura are necessary for function and nowhere in Nagura does it teach or suggest total coverage with a hydrophobic coating.

There is as such not teaching in either patent to combine it with the other and even if so combined, there is no incentive to do so, since the coating of Hope is hygroscopic in nature just like that of Nagura.

Further, as noted at the onset of this application, the material aspects of aqueous processing originally claimed are entitled to consideration. The language of the originally included processing ability has been amended for clarity with the same material element therein.

## Conclusion

All of the objections and rejections raised by the Examiner have been addressed by Applicant. Attorney for Applicant has carefully reviewed the cited references, namely the Hope and Nagura publications. The lack of any teaching of a complete hydrophobic coating of the particle in either cited reference nor any incentive to do so along with their resulting inability for aqueous processing, Further it has been shown that applicant's combination of elements and its being processible in aqueous solutions is patentably distinguishable with respect to the prior art.

Further, as noted earlier, Applicant, teaches in the specification, the substantial improvement provided by their device and the great benefits in processing and storage of lithium batteries. However, even if the Examiner does not consider Applicant's claimed device a great advance, it has been established that one should not be deprived of patent protection where it can be shown that a genuine improvement has been made, on comparison with other intentions in the art, even if the improvement lacks the appearance of a *great* advance in the art. In *re Lange*, 128 USPQ 365, the CCPA on page 367 states that:

Further, the CCPA in the case of *re Meng and Driessen*, 181 USPQ 94, on page 97, reiterated the principal that one must beware of a hindsight analysis in that even though the invention seems a simple advance over prior art, *after the fact*, simplicity, argues *for*, rather than against patentability.

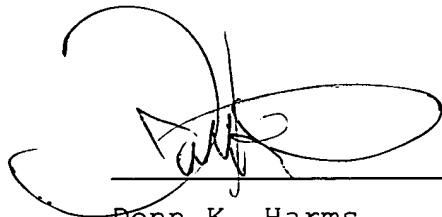
Considering that Applicant's device has elements neither taught or suggested in any one or combination of cited prior art, and, considering that major as well as minor improvements in the art, argue for patentability, the claims of the patent should now be allowable.

As such, Applicant submits that all of the claims of record are in condition for allowance and respectfully requests that a Notice of Allowance be issued in this case in due course.

Should the Examiner have any further questions or concerns the Examiner wishes to address by Examiner's amendment by telephone or otherwise, or

Should the Examiner have wording or other suggestions to more clearly define the subject matter of the claims to more clearly define the patentable subject matter, the Applicant's attorney would be most receptive to such by phone.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donn K. Harms', is written over a horizontal line.

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